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09/587,107	06/02/2000	Masahiro Oashi	NAK1-AS70r	6813

7590

06/18/2003

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EXAMINER

HONG, STEPHEN S

ART UNIT

PAPER NUMBER

2178

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17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/587,107

Applicant(s)

OASHI ET AL.

Examiner

JOSEPH H FEILD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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1. This office action is responsive to the Request for Continued Examination filed 4/29/03.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/29/03 has been entered.

3. In the supplemental Reissue Declaration filed March 25, 2003, applicant removed "the unnecessary amendments to Claims 1 and 4 that could have been corrected via a Certificate of Correction" (see rule 116 amendment, page 2). However, the examiner notes that those amendments can be kept in the claims. The previous objection to the Declaration was based on the fact that at least one error must be pointed out upon which a Reissue application can be based. Something that could have been corrected via Certificate of Correction does not constitute such an error. Therefore, the amendments to claims 1 and 4 in which "disc" was changed to "recording medium" will remain.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-9, 19-21, and 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

At the outset, the Examiner apologizes for not having introduced this rejection at the beginning of prosecution, and regrets the inconvenience caused to Applicants and their representative.

Four embodiments are disclosed in the specification. Embodiment 1 (multimedia playback device—figure 2, corresponding to claims 1-6 and 25-26) is disclosed at column 7, line 60 through column 18 (line 53); embodiment 2 (multimedia information record device—figure 12, corresponding to claims 7-9 and 19-21) is disclosed at column 18 (line 54) through column 22 (line 29); embodiment 3 (multimedia playback device—figure 16, corresponding to claims 10-15) is disclosed at column 22 (line 31 through column 24 (line 58); and embodiment 4 (multimedia information record device—figure 18, corresponding to claims 16-18 and 22-24) is disclosed at column 24 through column 25 (line 60). With respect to each of embodiments 1 and 2, the specification explicitly states the advantage that “successiveness” provides. Neither of embodiments 1 or 2 is described with respect to “non-successive” storage. Thus, in the present reissue application, the specification only provides support for information that is stored

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“successively”. Removal of “successively” from the claims would in effect remove an essential functional element.

Specifically, with respect to embodiment 1 (claims 1-6 and 25-26), refer to column 8 (lines 25 et seq): *Storage areas 401, 402, and 403 of the CD-ROM 201 continues successively on the track, and data stored in each of the storage areas is read one after another as the CD-ROM 201 turns.* Figure 4 shows “successive” storage (physically adjacent storage areas—conventional storage technique for CD-ROM). At column 17 (lines 16-41): *The contents of each page stream and each time line stream is successively stored on the same track of the CD-ROM, so head seek does not happen when the information is successively read. Speed of data readout from the same page stream and the same time line stream is fast and breaks in the sound and dynamic pictures do not happen, so that multimedia information is played back accurately.* At column 17 (lines 39-41): *. . . the load of the CPU is decreased, unlike the case in which the information are recorded in the different storage areas in the recording medium.* At column 18 (lines 10-15): *As the contents of the time line stream is successively stored on the same track, seek of a read head does not happen, even if the designated still picture data and audio data are loaded from the CD-ROM 201 at each display time. This enables displaying of dynamic pictures without breaks in sound and images.*

Thus, the specification clearly points out that “successive” storage is advantageous because it eliminates breaks in sound and dynamic pictures which would otherwise occur due to head seeks. The specification fails to teach any other method of

storing the information with respect to this embodiment. Since the specification clearly points out the advantages associated with “successively” storing with respect to the disclosed embodiment, then there is no support for removing “successively”. As such, the specification fails to provide enablement for claims 1-6 and 25-26.

With respect to embodiment 2 (claims 7-9 and 19-21), refer to column 19 (lines 1-6: *As shown in figure 13, elements of the hardware construction of the multimedia record device 1200 is almost the same as the multimedia information playback device 200 shown in figure 3, except that the multi-media information record device 1200 does not comprise the joy pad 306 but comprises a hard disc 1310.* At column 21 (line 62) through column 22 (line 18): *In step 1402, when the contents to be described do not exist in the page stream, the stream creation 1202 requests the input instructing order of recording the page stream and the time line stream successively onto the storage areas of the track of the CD-ROM 1210 (Step 1429). The stream creation unit 1202 posts the recording order to the CD-ROM write unit 1209. The CD-ROM write unit 1209 reads the page stream and the time line stream from the page stream storage unit 1207 the time line stream storage unit 1208, respectively, and stores them in the CD-ROM 1210 (Step 1430).* At column 22 (lines 12-15): *Also, each page stream and time line stream can be stored successively in the storage areas on the same track of the CD-ROM 1210.*

Again, the specification clearly discloses “successive” storage, and fails to provide support for removal of “successively” from the claims. Presumably, unless Applicant can prove otherwise, since non-successive storage is not disclosed with

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respect to this embodiment, the same advantages are implied as those described with respect to embodiment 1, except that embodiment 2 is directed toward recording, whereas embodiment 1 is directed to playback. Specifically, head seek would be avoided if the information is recorded "successively, and upon playback, there would be no breaks in the sound and images.

With respect to embodiment 3, the specification does not rely explicitly on "successive" storage of the information; rather, the playback device is connected to a data server (see column 22 (lines 30 et seq) and column 24 (lines 4-58)), and one page stream is stored as one file and one time line stream is stored as one file on the server. Since it was known by those of ordinary skill in the art that data stored on a hard disk (column 22, line 60) does not necessarily have to be stored "successively", the specification provides proper support for claims 10-15. A similar argument applies to embodiment 4 (corresponding to claims 16-18 and 22-24).

6. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

It is a requirement that the Declaration identify an error upon which a reissue application can be based (37 CFR §1.175(a)(1), MPEP §1414). The "error" that Applicant seeks to "correct" has led to a deficiency, as is outlined above with respect to 35 USC §112, 1<sup>st</sup> paragraph. Specifically, the amendment to claims 1-9, 19-21, and 25-26, in which "successively" has been deleted, has caused a deficiency under 35 USC §112, 1<sup>st</sup> paragraph.

7. Claims 1-26 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion above in this Office action.

8. Applicant's arguments have overcome the rejection of the claims with respect to impermissible recapture. The Examiner agrees that "successively" was never an issue with respect to overcoming the prior art rejection in the prosecution of the parent case (08/512,302). At page 34 of Amendment A of 08/512,302 (paper #6, filed 8/28/97), Applicant explicitly emphasized "pieces of page information" and "a plurality of images"—not "successively". Since "successively" was not included in all of the sets of claims, and all of the claims were allowed for the same reason (see Examiner's Amendment, paper #7, mailed 11/26/97), then impermissible recapture does not apply to the claims of this Reissue application.

9. Claims 1-26 contain allowable subject matter based on the prior art of record. Assuming Applicant is able to overcome the 35 USC §112, 1<sup>st</sup> paragraph rejection of claims 1-9, 19-21, and 25-26, the case can pass to issue if the "error" upon which this Reissue application is based remains "corrected". Otherwise, the case cannot pass to issue because the "error" upon which this Reissue application is based is the cause of



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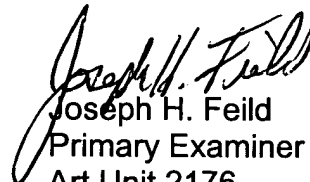
the §112 1<sup>st</sup> paragraph rejection. If Applicant amends the specification, the issue of new matter could possible arise.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH H FEILD whose telephone number is (703) 305-9792. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HEATHER HERNDON, can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are:

(703) 746-7238	<b>(After Final Communication)</b>
(703) 746-7239	<b>(Official Communication)</b>
(703) 746-7240	<b>(Status Inquiries, Draft Communication).</b>

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
Joseph H. Feild  
Primary Examiner  
Art Unit 2176  
June 13, 2003